Appl. No. 10/765,289
Amdt. dated December 4, 2008
Reply to Office Action of September 4, 2008

PATENT

REMARKS/ARGUMENTS

Claims 1-14 and 16-22 were previously canceled; claims 15 and 23-33 are pending. The Office Action mailed September 4, 2008 was designated "final". In the Office Action, claims 15 and 23-33 were rejected over the combination of U.S. Patent No. 6,895,461 to Thompson and U.S. Patent No. 6,292,838 to Nelson. The independent claims (23 and 29) have been amended to incorporate the feature of dependent claims (25 and 15, respectively), which state that the MAC address is obtained from the host computer by adoption of a protocol based on an iSCSI text mode negotiation.[1] None of the cited references operate in accordance with the MAC address feature and cannot provide the feature, taken alone or in combination. It is asserted that entry of this Amendment After Final is proper, because the amendment addresses features of already-examined dependent claims and therefore raises no new issues, and because the amendment will place the application in condition for allowance and, failing that, in better form for appeal.

Combining the References Would Not Provide the Claimed MAC Address Feature

With respect to the MAC address feature of claims 15 and 25 (incorporated into the respective independent claims 29, and 23), the Office Action asserted that this feature was provided by Thompson at column 7, lines 45-58. That portion of Thompson, however, merely describes how the computers use a storage router IP address to determine the routers for SCSI communications, and the routers use an access list to determine which computers can be granted access to storage devices. Thompson elsewhere notes that "[the] access list 322 identifies which computers 127-128 can access storage devices 140 attached to it" (see col. 9, lines 50-52). The access list is maintained at each storage router and is said to specify "the IP addresses of servers allowed to access a common set of storage resources via the storage router" (see col. 9, lines 25-28).

Thus, nowhere does Thompson state or suggest using a MAC address associated with the host computer to access a logical unit (LU). Moreover, Thompson does not state or

---

[1] Both of the independent claims refer to determining whether the MAC address has been cataloged in an access management table that defines the MAC address identifying the host computer by IP address. The feature being added relates to how that MAC address is obtained.

Appl. No. 10/765,289
Amdt. dated December 4, 2008
Reply to Office Action of September 4, 2008

PATENT

suggest obtaining the MAC address via an iSCSI text mode negotiation protocol, which is the manner recited in the pending claims.

Using the MAC address to determine access approval is described in the specification, for example, at the last two paragraphs of Page 10 (paragraphs [0036] and [0037] of the published application):

> In accordance with the present invention, in a storage apparatus connected to an IP network as a storage apparatus adopting an iSCSI protocol, a host is identified by using a MAC address in order to determine whether or not to approve a login request made by the host.

> In addition, a method of processing a login request and a method of managing accesses can be modified in accordance with whether or not the host serving as an initiator of accesses pertains to the same network or the same segment as the storage apparatus. Thus, it is possible to enhance security of an access request made by the host as a request for an access to the storage apparatus.

The other reference cited in the Office Action, the patent to Nelson, describes determining a MAC address corresponding to an IP address in a network by a complicated scheme of sending a series of Address Resolution Protocol (ARP) messages and receiving back a string of reply packets to thereby reconstruct the chain of routers that lie between the host and the target (col. 3, lines 18-26 and lines 43-48). Thus, Nelson makes no use of the access management table recited in claims 23 and 29 that that includes host MAC addresses obtained from the host computer by adoption of a protocol based on an iSCSI text mode negotiation.

Neither Thompson nor Nelson teaches or suggests determining permitted access using MAC addresses. Thus, even if the cited references could be successfully combined, they cannot provide elements that can perform the functions of the amended claims. That is, combining Thompson with Nelson would not perform all the functions of the claimed features. Therefore, there is no *prima facie* showing of obviousness with respect to the pending claims, and the claims are patentably distinguished.

Appl. No. 10/765,289
Amdt. dated December 4, 2008
Reply to Office Action of September 4, 2008

PATENT

There Is No Reasonable Expectation of Successful Combining

It is asserted that Nelson cannot operate with Thompson, because Nelson is not configured to operate with a Fibre Channel network such as described in Thompson and in the pending claims. Rather, Nelson is configured strictly for operation with IP packets and ARP messaging (see Abstract and col. 3, lines 11-35). Hence, it is asserted that there is no reasonable expectation of successfully combining Thompson and Nelson. As noted at M.P.E.P. § 2143.02, obviousness requires a reasonable expectation of successfully combining the references. A suitable rationale to support a conclusion that a claim would have been obvious is that "all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions" (citing KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007)).

Thompson relates to a storage router that has an IP port for Internet Protocol communications and a Fibre Channel port for communicating with SCSI targets (see col. 2, lines 52-64 of Thompson), whereas Nelson is directed to associating IP address information of hosts when a router is interposed between a host and a destination across an IP network (col. 2, lines 3-24 of Nelson). Because Thompson and Nelson cannot interoperate, and any attempted combination of them would require a change in their respective functions, it is submitted that there is no *prima facie* case of obviousness.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.
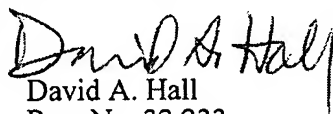
/

/

/

Appl. No. 10/765,289
Amdt. dated December 4, 2008
Reply to Office Action of September 4, 2008

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,

David A. Hall
Reg. No. 32,233

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 858-350-6100
Fax: 415-576-0300
Attachments
DAH:dah
61718063 v1